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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,762	11/14/2001	J. Keith Joung	MTV-030.02	2226

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EXAMINER
BYRD, DEVON R

ART UNIT	PAPER NUMBER
1639	11

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary	Application No.	Applicant(s)	
	09/990,762	JOUNG ET AL.	
	Examiner	Art Unit	
	Devon R Byrd	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 February 2002* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Status of the Claims

Claims 1-20 are pending in the present application and are subject to restriction and election of species.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, drawn to a method for selecting a dimerizing test polypeptide, classified in class 435, subclass 7.8.

II. Claims 10-15, drawn to a method for selecting a composite transcription factor, classified in class 435, subclass 69.1.

III. Claims 16-20, drawn to a method for detecting on interaction between a test polypeptide and a DNA sequence, classified in class 435, subclass 6.

Although there are no provisions under the section for "Relationship of Inventions" in MPEP § 806.05 for inventive groups that are directed to different methods, restriction is deemed proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups I-III are directed to methods that recite structurally and functionally distinct elements, are not required for one another, and achieve different goals. Group I requires two or more binding sites (DBD recognition elements), which are not required for any of the other groups. Group II requires a gene that encodes a DNA-binding domain of known specificity, which is not required for any of the other groups. Group III requires a second reporter gene, which is not required for any of the other groups. Therefore a search and examination of all three

methods in one patent application would result in an undue burden, since the subject matter, and literature and sequence searches for the three methods are divergent.

Because these inventions are distinct for the reasons given above, and

a. have acquired a separate status in the art as shown by their different classification;

b. have different and separately burdensome manual and/or computer structure, name, and bibliographical searches; and,

c. have divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Election of Species (All Groups)

This application contains claims that are generic to a plurality of disclosed patentably distinct species comprising:

a) host cells (prokaryotic or otherwise) as disclosed on p 67, e.g., (a) eukaryotic- yeast or mammalian; (b) prokaryotic- E. coli or B. subtilis

b) DNA-binding domains as disclosed on p 82, e.g., a zinc finger moiety

c) an activation domain

d) a (first, second, or otherwise) reporter gene as disclosed on p 81 and 82, e.g., HIS3, lacZ

e) binding sites (DBD recognition elements, or otherwise) as disclosed on p 83, e.g., TATA, p53, NRE, Zif

f) desired level of expression of the reporter gene, e.g., a growth advantage, a detectable signal

g) a composite transcription factor as disclosed on p 78 and 79, e.g., Gal11P-Zif123, αGAL4

h) a DNA sequence as disclosed on p 79, lines 5-11

i) a weak DNA-binding domain

j) an activation tag

The species mentioned above have different and separately burdensome manual and/or computer structure, name, and bibliographical searches; and have divergent subject matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, even though this requirement is traversed.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon R Byrd whose telephone number is 703-305-0159. The examiner can normally be reached on Mon-Fri 8a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-2317. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-308-2742 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

BENNETT CELSA
PRIMARY EXAMINER

DB
August 22, 2003